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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197819
Party	Defendant Campo de' Fiori, LLC
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Date	01/20/2012
Attachments	Answer to Notice of Opposition with Affirmative Defenses.pdf ( 6 pages )(37566 bytes )

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**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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I MATTI RISTORANTE, INC.,	:	
	:	
<i>Opposer,</i>	:	Opposition No. 91197819
	:	
vs.	:	Mark: CAMPO DE' FIORI
	:	
CAMPO DE'FIORI, LLC,	:	Serial No.: 85010592
	:	
<i>Applicant,</i>	:	
	:	
.....	:	

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

## **ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES**

Applicant, Campo De' Fiori, LLC, by its attorney hereby submits its Answer to Notice of Opposition filed by Opposer, I Matti Ristorante, Inc., as follows, with the following numbered Paragraphs corresponding to the numbers of the Paragraphs of the Notice of Opposition:

1. Applicant has insufficient knowledge to affirm or deny the allegations in Paragraph 1.
2. Applicant admits the allegations of Paragraph 2.
3. Applicant has insufficient knowledge to form an opinion or belief as to the allegations of Paragraph 3 except that Applicant admits that:
  - a. Registration No. 2,348,945 was filed on June 20, 1997;
  - b. Opposer's trademark application, Serial No. 76,471,175, was abandoned on July 16, 2007;
  - c. a purported assignment of Registration No. 2,348,945 to Opposer was recorded on March 7, 2007; and
  - d. Registration No. 2,348,945 was canceled for failure to file a §8 Declaration of Continued Use.
4. Applicant has insufficient knowledge to form an opinion or belief as to the allegations of Paragraph 4.
5. Applicant has insufficient knowledge to form an opinion or belief as to the allegations of Paragraph 5.
6. Applicant has insufficient knowledge to form an opinion or belief as to the allegations of Paragraph 6.
7. Applicant admits the allegations of Paragraph 7 but questions the characterization of the restaurant attributed by the article.
8. Applicant admits the allegations of Paragraph 8.
9. Applicant admits the allegations of Paragraph 9.

10. Applicant admits the allegations of Paragraph 10.
11. Applicant admits the allegations of Paragraph 11.
12. Applicant admits the allegations of Paragraph 12.
13. Applicant admits the allegations of Paragraph 13.
14. Applicant admits the allegations of Paragraph 14.
15. Applicant admits the allegations of Paragraph 15 with the exception that Applicant has insufficient knowledge to affirm Opposer's information and belief.
16. Applicant denies the allegations of Paragraph 16.
17. Applicant denies the allegations of Paragraph 17 with the exception that Opposer's use of its CAMPO DE FIORI mark is likely to cause confusion, cause mistake, deceive the public, dilute Applicant's mark, and cause the public to incorrectly believe that the goods sold under the CAMPO DE FIORI mark emanate from or are otherwise sponsored or endorsed by Applicant in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

As and for Affirmative Defenses, Applicant states as follows:

#### FIRST AFFIRMATIVE DEFENSE

For its First Affirmative Defense, Applicant states that it is entitled to the registration of its CAMPO DE' FIORI mark on the Principal Register of the United States Patent and Trademark Office.

Prior to filing its trademark application for CAMPO DE' FIORI, Applicant performed a search of the available trademark records and found that there were no active or pending registrations of the CAMPO DE' FIORI mark in any relevant International Class. At the time of its search, Applicant noted that Registration No. 2,348,945 (CAMPO DE FIORI) had been canceled on July 26, 2007 for failure to file a Section 8 Declaration of Continued Use; and, trademark application Serial No.

76471175 (CAMPO DE FIORI) had been abandoned on July 16, 2007. In view of the fact that there were no active or pending trademark registrations and/or applications for CAMPO DE' FIORI or similar marks, Applicant filed its trademark application for CAMPO DE' FIORI on April 9, 2010.

That there were no conflicting marks at the time of Applicant's filing of its trademark application was later confirmed by the July 20, 2010 Office Action in connection with Applicant's trademark application in which Trademark Examiner Fink stated “[T]he trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d). “See July 20, 2010 Office Action for Application/Serail No. 85/010592 .

Opposer did not file its trademark application for its CAMPO DE FIORI mark until August 18, 2010. As a result, the April 9, 2010 filing date of Applicant's trademark application has priority over that of Opposer's.

Therefore, in view of there having been no active or pending trademark registrations and/or applications for CAMPO DE' FIORI or any similar mark(s) prior to Applicant filing its trademark application for CAMPO DE' FIORI, and Applicant's trademark application for CAMPO DE' FIORI possessing a filing date prior to that of Opposer's application, Applicant respectfully petitions the Trademark Trial and Appeal Board (hereinafter, “Board”) to allow its trademark application for CAMPO DE' FIORI to continue to registration.

## SECOND AFFIRMATIVE DEFENSE

For its Second Affirmative Defense, Applicant states that Opposer's prior interest in the canceled Trademark Registration No. 2,348,945 (CAMPO DE FIORI) and the willfully abandoned trademark application Serial No. 76,471,175 (CAMPO DE FIORI) does not grant Opposer's current trademark application Serial No. 85110181 (CAMPO DE FIORI) priority over that of Applicant.

Whatever rights of priority Opposer may have had in Trademark Registration No. 2,348,945 (CAMPO DE FIORI) and trademark application Serial No. 76,471,175 (CAMPO DE FIORI) were lost following the respective six month grace period and two month revival period subsequent to it receiving a Notice of Cancellation of Registration and a Notice of Abandonment of Application by the United States Patent and Trademark Office (hereinafter, "USPTO"). See 37 C.F.R. §2.160(a)(3), and 37 C.F.R. §2.66(a)(1)(2).

At no time following the Notice of Cancellation of Trademark Registration No. 2,348,945 (CAMPO DE FIORI) did Opposer attempt to rehabilitate said registration or attempt to promptly file a trademark application to prevent an intervening use or registration by a third-party.

It was not until after three months following the filing of Applicant's trademark application for CAMPO DE' FIORI (more than three years after the respective cancellation and abandonment of Trademark Registration No. 2,348,945 (CAMPO DE FIORI) and trademark application Serial No. 76,471,175 (CAMPO DE FIORI)) that Opposer filed its current trademark application.

Therefore, in view of Opposer having taken no rehabilitative action(s) with respect to its canceled and abandoned marks and it having taken no pro-active steps to protect its alleged mark during the three or more years prior to Applicant filing its trademark application for CAMPO DE' FIORI, Applicant respectfully asks that the Board allow Applicant's trademark registration for CAMPO DE' FIORI to continue to registration.

### THIRD AFFIRMATIVE DEFENSE

For its Third Affirmative Defense, Applicant states that the assignment of Trademark Registration No. 2, 348,945 (CAMPO DE FIORI) to Opposer was invalid.

By Opposer's own admission in its Notice of Opposition, Opposer "...did not become assignee/owner of the mark until after the due date for the Section 8 Declaration, namely, the sixth year from the date of registration which was between May 9, 2005 and May 9, 2006. Opposer did not

become assignee/owner of Registration No. 2,348,945 until February 27, 2007.” See Notice of Opposition paragraph 3. Applicant therefore contends that there was, in fact, no registration to have been assigned to Opposer since the failure to file a Section 8 Declaration by May 9, 2006 would have caused said registration to be canceled. Even taking into consideration the six month grace period following cancellation (see 37 C.F.R. §2.160(a)(3)), said grace period would have expired on November 9, 2006, more than three months prior to the purported February 27, 2007 assignment to Opposer.

Therefore, because of the invalid assignment of Trademark Registration No. 2,348,945 (CAMPO DE FIORI) to Opposer, Opposer never had a legitimate interest in said registration.

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be rejected and Applicant's trademark application for CAMPO DE' FIORI be allowed to proceed to registration.

Respectfully submitted

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Attorney for Applicant

#### CERTIFICATE OF SERVICE

I hereby certify that the above and foregoing Answer to Notice of Opposition with Affirmative Defenses was served upon Opposer by electronic mail on this 20<sup>th</sup> day of January, 2012 addressed to

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